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10/791,378

03/03/2004

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EXAMINER

DAWSON, GLENN K

ART UNIT

PAPER NUMBER

3731

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DELIVERY MODE

05/25/2007

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/791,378

Applicant(s)

RIIHIMAKI ET AL.

Examiner

Glenn K. Dawson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4,8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Amico-5429613.

D'Amico discloses a needle attached to a handle of octagonal cross-section (see fig. 1 and 6), star-shape (70 fig. 11) or rectangular shape (fig. 20).

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Pike-5954698.

Pike discloses a needle attached to a handle having a hexagonal cross-sectional shape.

Claims 1,2 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulik-1551159.

Kulik discloses a needle attached to a handle having a cross-section with a round portion and a chord-see fig. 5.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence-6346115.

Lawrence discloses a needle attached to handle of rectangular cross-section.

See fig. 5.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilkens, et al.-WO 98/23321.

Wilkens discloses a needle attached to a handle of hexagonal cross-section see fig. 4-6.

Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Nissan, et al-2003/0093084.

Nissan discloses a needle attached to a handle of triangular cross section.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohana-EP-0082081.

Ohana discloses an acupuncture needle and a handle which as seen in fig. 2 has a cross section with a circular portion and two parallel chords or flat surfaces.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3-9,14,15,16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang-4950279.

Chang discloses an acupuncture needle attached to a handle having surface indentations 24. However, the claimed shapes of the handle are not disclosed. However, it is well known in the art that providing a handle with a polygonal cross-section, as evidenced by all of the previously cited references, provides the user with improved dexterity or frictional surfaces to apply torque. To have provided these additional configurations to the handle of Chang would have been an obvious design choice as merely being an obvious known alternative to the simple pineapple etching of Chang.

The needle is used during acupuncture by piercing the skin and then rotating the needle. When the above combination is made to modify the handle, the claimed method will be achieved when the modified needle is rotated by the user.

The needle appears to be solid; however, it would have been obvious to have made it solid to reduce the degree of pain and prevent possible coring of the tissue.

Claims 2, 10-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang-'279 in view of Mink-5896620.

Chang discloses the invention as claimed with the exception of the circle/chord cross section. However, Mink discloses such a cross-sectional handle see fig. 9. It would have been obvious to have provided a flat onto the handle of Chang in order to provide the handle with a thumb rest. To have provided a second chord portion would have been a mere obvious duplication of known parts, and would have allowed for a thumb rest convenient to the user regardless in which circumferential orientation the user grips the handle. The needle is used during acupuncture by piercing the skin and then rotating the needle. When the above combination is made to modify the handle, the claimed method will be achieved when the modified needle is rotated by the user.

The needle appears to be solid; however, it would have been obvious to have made it solid to reduce the degree of pain and prevent possible coring of the tissue.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkens-'321.

Wilkens discloses the invention as claimed with the exception of the explicit disclosure of the needle being solid.

The needle appears to be solid; however, it would have been obvious to have made it solid to reduce the degree of pain and prevent possible coring of the tissue.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang-'279.

The needle appears to be solid; however, it would have been obvious to have made it solid to reduce the degree of pain and prevent possible coring of the tissue.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence-'115

The needle appears to be solid; however, it would have been obvious to have made it solid to reduce the degree of pain and prevent possible coring of the tissue.

### ***Response to Arguments***

Applicant's arguments filed 03-12-2007 have been fully considered but they are not persuasive.

Applicant's arguments are not persuasive as the prior art needles are capable of being rotated very quickly which would cause the claimed vibration. No particular structure is inherent concerning the term "acupuncture". The applicant does not have the support for the needle being solid as this feature is not inherent in acupuncture needles as evidenced by Cohen-FR 2 635 003.

Flat regions on handles are commonly designed to increase the user's ability to grip the handle and/or rotate it. Providing flat regions as a gripping enhancement feature instead of the pineapple pattern is a mere substitution of known alternatives, and as such is an obvious design choice. The cited prior art shows these flattened sections on handles to be well known structures.

Mink is analogous art as applicant was looking for handle structures which increased the user's ability to rotate the needle. Mink discloses a handle arrangement and shape which would allow a user an adequate gripping surface which would not make the user re-position the angular orientation of the handle in the hand in order to manipulate the handle and needle.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

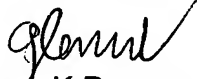


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3731

gkd  
23 May 2007